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| APPLICATION NO.                                      | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.               | CONFIRMATION NO.       |
|--|-------------|----------------------|-----------------------------------|------------------------|
| 10/604,974   | 10/29/2003  | Robert O'Kane        | 001-205                           | 1973                   |
| 29569  | 7590        | 09/15/2009           |                                   |                        |
| FURR LAW FIRM<br>2622 DEBOLT ROAD<br>UTICA, OH 43080 |             |                      | EXAMINER<br>NGUYEN BA, HOANG VU A |                        |
|  |             |                      | ART UNIT<br>2421                  | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>09/15/2009           | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |  |                                       |  |
|------------------------------|--|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/604,974     | <b>Applicant(s)</b><br>O'KANE, ROBERT |  |
|                              | <b>Examiner</b><br>Hoang-Vu A. Nguyen-Ba | <b>Art Unit</b><br>2421               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 07 August 2009.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 11-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## DETAILED ACTION

### *Continued Examination Under 37 CFR 1.114*

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 7, 2009 has been entered.
2. Claims 11-19 are pending. Claim 11 is an independent claim.

### *Response to Amendments*

3. Per Applicant's request, Claims 3-10 have been canceled and new claims 11-19 have been added.
4. The amendment filed September 30, 2008 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: pages 26-42.

Applicant is required to cancel the new matter in the reply to this Office Action.

Contrary to Applicant's arguments, in p. 2 of Applicant Arguments/Remarks Made in an Amendment filed August 7, 2009 that no new matter has been added to the amended specification, the Office respectfully notes from the following table (which lists only one so-called embodiment of a total of 73 embodiments described in the amended specification for the sake of argument):

| Original Specification  | Amended Specification (Sep 30, 2008)  |
|---|---|
| [0035] I: <i>Claims is – USER/CLIENT DATABASE (OR STORAGE UNIT)</i><br>One component of the trigger regulated process stems from the Data Base of users, and Unique Triggers. The Trigger which has been installed, downloaded or acquired by the end | <u>Embodiment #1: The first component of the DTR platform provides means of regulating processes within the Database of users and their respective DTR Regulator's [sic]. The REGULATOR is actually programmed in real time by a user and then installed on each of the</u> |

|   |   |
|---|---|
| user provides the tool needed to fulfill the processes of content selection, distribution of content. The Trigger works with the Trigger Database (or storage unit) and provides: | <u>owners [sic] Digital Tuner equipped devices. Once installed, that user's REGULATOR provides means to authenticate, manage the processes between the centralized user databases, the ad databases, the royalty distribution databases, the content databases and the Digital Tuner equipped device.</u> |
|---|---|

that the amended specification introduces at least the following new subject matters which were not present in the corresponding section of the original specification: DTR platform, their respective DTR Regulator's [sic], the REGULATOR, actually programmed in real time by a user, each of the owners [sic] Digital Tuner equipped devices, authenticate, manage the processes between the centralized user databases, the ad databases, the royalty distribution databases, and the Digital Tuner equipped device.

5. The objection to Claims 3-6 is withdrawn in view of Applicant's cancellation of these claims.

6. The rejection of Claims 3 and 7-9 is withdrawn in view of Applicant's cancellation of these claims.

### ***Response to Arguments***

7. Applicant asserts that the art of record Reisman is not prior art because it postdates the effective filing date of the instant application which claims the priority dates of November 21, 2001 and of December 4, 2001 of nonprovisional applications no. 10/002, 267 and 09/683,228, respectively. The Office respectfully disagrees with Applicant's assertion for the following reasons:

- a. the specifications of the instant application and those of the two nonprovisional applications are different;
- b. Applicant fails to amend the instant application to include a reference to each of the two prior-filed applications or file an Application Data Sheet in a timely manner (see MPEP 201.11).

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Therefore, the priority date of the instant application is August 28, 2002 which is that of the provisional application no. 60/319,506 and the application of Reisman is proper and maintained.

### ***Claim Rejections – 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejection under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for the purposes of this subsection of an application filed in the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 11-19 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Application Publication No. 2003/0229900 A1 by Reisman.

It should be noted that hereinafter the use of the clause “see at least” should be interpreted that the cited portions that follow the clause are not the only portions that are considered to be relevant. Should Applicant find that the cited portions are not relevant, other portions of the disclosure of the prior art reference will be provided as additional evidence and/or context to the relevancy of the previously cited portions. Since the evidence is from the same reference, the introduction of the additional evidence in response to Applicant’s arguments should not therefore be considered to be that of new grounds of rejection.

### **Claim 11**

Reisman discloses at least *a process comprising a user system (see at least FIG. 1) that includes a client platform (see at least FIGs. 1-2, platform 128 ) connected to a two way digital tuner equipped device (see at least [0112]; [0176]; [0199]; [0235], e.g., PC-DTV), said client platform regulating processes that authenticate users, content, advertisement (see at least [0292]; [0295-0296]), and royalty distribution (see at least [0529]; [0616]), and said client platform recognizing and reporting to a server platform (see at least FIG. , platform 110) the*

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*following information: data about the user (see at least [0302]; [0369-0370]; [0512]; [0537]), the times of user activity (see at least [0189]), the content type ([0026]), the name of said content (see at least [0062]), the time that said content was made available to users by the owner of the content, the number of times said content has been used by or transferred to or among the users (see at least FIG. 6; [0029-0030]), e.g., tracking activity; profiling in [0290], [0370]), the advertisement consumption options (see at least [0526]; [0616]), which advertisement the user has or has not selected in the past (see at least [0526]), the amount of royalties paid, and to whom said royalties were paid (see at least [0525-0529]).*

**Claim 12**

The rejection of base claim 11 is incorporated. Reisman further discloses *wherein said client platform further controls one or more of the following processes: a selection/or non-selection of content (see at least [0030]; [0115]; [0121-0122]; [0125]), a selection or non-selection of ads (see at least [0115]), playing content, or storing content (see at least [0030]; [0073]; [0118]; [0197]; [0306]).*

**Claim 13**

The rejection of base claim 11 is incorporated. Reisman further discloses *generating said client platform for each unique user (see at least [0002]; [0023]).*

**Claim 14**

The rejection of base claim 11 is incorporated. Reisman further discloses *having said information being stored in one or more databases (see at least FIG. 1, device 160 or on the iTV/PC), apis (see at least [0137]) or storage units (see at least FIG. 1, device 160 or storage components in devices 130, 140, 150), and for which said information is controlled by the actions of said user's input into said user system (see at least FIG. 1, user's input via device 130, 140 or 150).*

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**Claim 15**

The rejections of the base claim 11 and intervening claim 14 are incorporated. Reisman further discloses *wherein said database is contained within said user system* (see at least FIG. 1, database stored on iTV's memory to PC; [0118]; [0610]).

**Claim 16**

The rejection of base claim 11 is incorporated. Reisman further discloses *wherein said user system is a television receiver* (see at least FIG. 1, device 130).

**Claim 17**

The rejection of base claim 11 is incorporated. Reisman further discloses *wherein said user system is a computer* (see at least FIG. 1, 140).

**Claim 18**

The rejection of base claim 11 is incorporated. Reisman does not specifically disclose *assigning a unique code for each respective advertisement uploaded by a participating advertiser*.

However, Reisman discloses participation of advertisement authors in [0071]. Thus, the feature of assigning a unique code for each respective advertisement uploaded by a participating advertiser is deemed inherent to Reisman because without such an identification code, how could content providers keep track of advertisements targeted to customers for customization and billing purposes.

**Claim 19**

The rejection of base claim 11 is incorporated. Reisman further discloses *wherein said user system comprises a set top box connected to a display device* (see at least FIG. 2b, STB 260 connected to TV 262).

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hoang-Vu “Antony” Nguyen-Ba whose telephone number is

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(571) 272-3701. The examiner can normally be reached on Monday-Friday from 9:00 am to 5:30 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, John Miller can be reached at (571) 272-7353.

The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Any inquiry of a general nature or relating to the status of this application should be directed to the TC 2400 Group receptionist (571) 272-2400.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Hoang-Vu Antony Nguyen-Ba/

Primary Examiner, Art Unit 2421

September 10, 2009